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STREETS & STEELE - IBM CORPORATION 13100 WORTHAM CENTER DRIVE, SUITE 245 HOUSTON, TX 77065			EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM G. PAGAN

Appeal 2009-007833
Application 10/602,425
Technology Center 2100

Before JEAN R. HOMERE, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claims 1-4, 6, 10, 12-16, 21, 23-27, 32, 35-37, 39, 41, 43, and 45-52. Claims 5, 7-9, 11, 17-20, 22, 28-31, 33, 34, 38, 40, 42, and 44 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We Reverse.

Claim 1 is illustrative:

1. A method for providing a hot key corresponding to a particular function in a computer system, the computer system having a graphical user interface (GUI) and including a pointing device enabling a user to select items displayed in the GUI, the particular function provided for a context of an application program, the user providing input within the context, the method comprising the steps of:

integrating a hot key configuring function into the GUI such that a user can access the hot key configuring function from within the context and without leaving the context, wherein the context includes a displayed item displayed in the GUI corresponding to the particular function, and wherein the particular function is performed in response to the displayed item being selected by the pointing device; and

mapping the hot key to the particular function and storing the mapping, the mapping and storing performed without the user leaving the context and in response to the user utilizing the hot key configuring function in the context, wherein the mapping causes the particular function to be accessed by the computer system when the mapped hot key is selected, and wherein the mapping includes:

receiving an indication of the particular function to which the hot key is to be mapped, the indication provided by the user moving the pointing device over the displayed item to indicate the particular function corresponding to the displayed item for the mapping, wherein the same displayed item is selectable by the pointing device to perform the particular function and is indicable by the pointing device to indicate the particular function for the mapping; and

receiving a key combination as the hot key in response to the user selecting the key combination using a hardware input device, the key combination being received after the indication of the particular function to which the hot key is to be mapped has been received.

The Examiner relies on the following prior art references as evidence of unpatentability:

Forest	US 5,999,895	Dec. 7, 1999
Slaunwhite	US 2003/0090471 A1	May 15, 2003

Appellant appeals the following rejections:

1. Claims 1-4, 6, 12-16, 23-27, 35, 37, 39, 41, 43, 45, and 49-52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Slaunwhite.
2. Claims 46-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slaunwhite.
3. Claims 10, 21, 32, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slaunwhite and Forest.

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Did the Examiner err in finding that Slaunwhite discloses:

receiving an indication of the particular function to which the hot key is to be mapped, the indication provided by the user moving the pointing device over the displayed item to indicate the particular function corresponding to the displayed item for the mapping, *wherein the same displayed item is selectable by the pointing device to perform the particular function and is [indictable] by the pointing device to indicate the particular function for the mapping*, within the meaning of independent claim 1?

ANALYSIS

Appellant contends that the independent claims recite mapping a hot key to a particular function by interacting a pointing device with *the same displayed item that can be selected to perform that function*. (App. Br. 12)(emphasis added). Appellant contends that these features are not disclosed in Slaunwhite. Based upon our review of the record, we agree.

The Examiner contends that Slaunwhite discloses a particular function being performed when a corresponding displayed item is selected by a pointing device. (Ans. 11-12) In addition, the Examiner contends that Slaunwhite discloses a shortcut key assignment. (Ans. 12). However, we agree with Appellant that the first cited portion of Slaunwhite (paras. [0033-0035] discloses selecting an item from a toolbar to perform a function, but does not also *indicate the particular function for the mapping*, as required by the commensurate language of each independent claim on appeal. (Reply Br. 11).

Moreover, we also agree with Appellant that the customizable hot key mapping described in Slaunwhite [e.g., para. 0036] merely allows a user to map a function to a hot key, but does not also perform the function when selected. We find, as argued by Appellant, that the claim language requires that *the same displayed item* be used to both indicate the function for the mapping *and* to perform the function. (Reply Br. 4).

Therefore, for essentially the same reasons argued by Appellant, and for the reasons further discussed above, we reverse the Examiner's anticipation rejection for each independent claim on appeal. We note that independent claims 12 and 23 recite commensurate limitations. Therefore, we reverse the rejections of claims 12 and 23 for the same reasons as claim 1.

Because we have reversed the Examiner's rejection of each independent claim on appeal, we also reverse the Examiner's anticipation and obviousness rejections for each dependent claim. Regarding the § 103 rejection of claims 10, 21, 32, and 36, the Examiner has not shown, and we do not find, that the secondary Forest reference cures the aforementioned deficiencies of Slaunwhite.

CONCLUSION

On this record, the Examiner's legal conclusion of obviousness is not supported by the evidence regarding the specific limitations disputed by Appellant that we have addressed above.

DECISION

We reverse the Examiner's §102 rejections of claims 1-4, 6, 12-16, 23-27, 35, 37, 39, 41, 43, 45, and 49-52.

We reverse the Examiner's § 103 rejections of claims 10, 21, 32, 36, and 46-48.

ORDER

REVERSED

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